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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,582	12/22/1999	STEVEN B. SOLOMON	067251.0105	6338

7590 10/03/2003

BAKER & BOTTS
2001 ROSS AVENUE
DALLAS, TX 75201

EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/470,582

Applicant(s)
Solomon et al

Examiner
James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 31, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-14, 16-26, 28-32, and 34-38 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-14, 16-26, 28-32, and 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. The amendment filed on July 31, 2003 under 37 CFR 1.111 is sufficient to overcome the Quinlan et al (US2002/161641) reference by amending the priority claim.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4-14, 16-26, 28-32, and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finsterwald (6,039,244) in view of Freeman et al (6,450,407).

Claims 1, 8, 9, 12, 20, 21, 24, 32, and 36: Finsterwald discloses a system, apparatus, and method for processing rebates, comprising:

- a. A promotion database describing various rebate offers received from sponsors (col 2, lines 46-65 and col 3, lines 57-62);

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b. A transaction database describing purchases made by customers of one or more merchants (col 2, lines 46-65 and col 3, lines 57-62);

c. Receiving rebate a rebate request from a customer, the request including at least the customer's identity, the identity of the product for which the rebate is requested, and the identity of the corresponding transaction (e.g. customer name and address/account number, the UPC code for the rebated product, and the transaction/receipt number of the corresponding purchase)(col 2, lines 46-65; col 8, lines 19-21; and col 8, line 54 - col 9, line 44); and

d. Providing a status report of a rebate to the customer (col 10, lines 21-25).

However, Finsterwald does not explicitly disclose generating promotion reports for the sponsors. Freeman discloses a similar system, apparatus, and method for processing rebates and further discloses generating promotion reports for the sponsors (11, lines 16-29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to generate promotion reports for the sponsors in Finsterwald. One would have been motivate to generate such reports for the sponsors in view of Finsterwald's disclosure that maintaining demographic and transaction histories for the customers and for generating targeted messages based on such an information. Generating reports for the sponsors of these promotional programs would enable the sponsor to ascertain the effectiveness of various types of programs and, thus, target future promotional programs even better.

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Claims 2, 16, and 28: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 1, 8, and 20 above, and Finsterwald further discloses a plurality of rebate payment options available to the customer (col 2, lines 25-33 and col 6, lines 28-31).

Claims 4, 11, and 23: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 1, 8, and 21 above. Finsterwald further discloses that it is customary “to send data or addresses via the postal route” (col 2, lines 8-10). Likewise Freeman also discloses allowing the customer to mail in the request form (col 3, lines 53-59). While Finsterwald discusses the advantages of not having to send the data via the postal route, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the customer in Finsterwald to mail in the rebate form instead of submitting it over a communication line such as the Internet or telephone system. One would have been motivated to allow the customer to mail in the rebate form in order to give the customer one more (well known) way to submit the data, especially if the customer is away from home (e.g. on vacation) and does not have access to an Internet connection nor telephone line (e.g. in a foreign country).

Claims 5, 13, 25, and 38: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 1, 8, 24, and 32 above, and Freeman further discloses the promotion reports includes all pertinent information about the rebate program, such as number of rebates, breakage rate, name and addresses of requestors, etc. (col 11, lines 16-29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was

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made to generate promotion reports including the above information to the sponsors in Finsterwald. One would have been motivate to generate such reports for the sponsors in view of Finsterwald's disclosure that maintaining demographic and transaction histories for the customers and for generating targeted messages based on such an information. Generating reports for the sponsors of these promotional programs would enable the sponsor to ascertain the effectiveness of various types of programs and, thus, target future promotional programs even better.

Claim 6: Finsterwald and Freeman disclose a system for processing rebates as in Claim 1 above, and Finsterwald further discloses the customer receiving a status report on a submitted rebate request (col 10, lines 21-25).

Claims 7, 14, and 26: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 1, 8, and 20 above, and Finsterwald further discloses receiving verification/approval of the rebate request and that the disbursement of the rebate may take several forms. However, neither reference explicitly discloses receiving the selection of the rebate disbursement type from the customer. Official Notice is taken that it is old and well known to solicit a selection of a disbursement method from the receiver. For example, lottery winners are asked to select between at least two disbursement methods: lump sum of cash, or an annuity. Likewise, taxpayers due a refund are asked to select either a direct deposit of the refund to a financial account or to receive a physical refund check through the postal mail. Finally, customer due a refund when returning a purchased item to a store are often given the choice of a cash rebate or a credit to their store credit account. Therefore, it would have been obvious to one

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having ordinary skill in the art to allow the customer in Finsterwald to select the desired disbursement method from among the several types of rebates disclosed by Finsterwald. One would have been motivated to allow the customer to select the disbursement method in order to provide greater customer service thereby increasing customer satisfaction with the system.

Claims 10, 22, and 37: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 9, 21, and 36 above, and Finsterwald further discloses receiving the information over a network, such as the Internet (col 8, line 19 - col 9, line 44).

Claims 17, 29, and 34: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 16, 28, and 33 above, and Finsterwald further discloses various disbursement options comprise a cash rebate and a credit voucher ("e-cash" and "rights of use of specific Internet services", i.e. a credit voucher for the Internet services)(col 2. Lines 25-33 and col 6, lines 28-31).

Claims 18, 30, and 35: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 16, 20, and 32 above, and Freeman further discloses the promotion including a product identifier, an end date for the promotion, and a geographic target for the promotion (col 10, line 48 - col 11, line 15). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such information in the promotion within Finsterwald. One would have been motivated to include the product identifier, an end date for the promotion, and a geographic target for the promotion in view of Finsterwald's disclosure of storing similar types of data, such as "the nature of the product or of

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the service, to the place of production or the point of sale, to the time of production or the time of sale and/or the price of the product or of the service” (col 3, lines 3-6) and customer-specific data such as “the name, the postal address, the telephone number, the age, the sex and/or the profession of the customer” (col 5, lines 12-16) and for using such data for targeted advertising which is selected based on the stored data (col 6, lines 46-48).

Claims 19 and 31: Finsterwald and Freeman disclose a method and apparatus for processing rebates as in Claims 8 and 20 above, and both references further disclose the transaction information including personal information of the purchaser and the purchase information (Finsterwald, col 2, lines 46-61 and col 4, lines 30-42)(Freeman, col 20, lines 53-59).

Response to Arguments

4. Applicant's arguments with respect to claims 1, 2, 4-14, 16-26, 28-32, and 34-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal

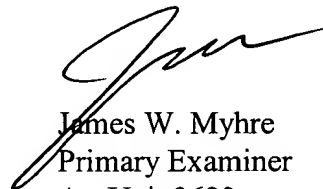
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or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM
September 27, 2003



James W. Myhre
Primary Examiner
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